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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,767

03/23/2007

Mitsuo Wada

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6369

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7590

11/15/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

VAJDA, PETER L

ART UNIT

PAPER NUMBER

1721

NOTIFICATION DATE

DELIVERY MODE

11/15/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/591,767	<b>Applicant(s)</b> WADA ET AL.	
	<b>Examiner</b> PETER L. VAJDA	<b>Art Unit</b> 1721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-8,10,12,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,6 and 15 is/are allowed.
- 6) ☒ Claim(s) 1,3,7,8,10,12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The applicant's reply filed 08/27/2010 has been received and considered. The applicant has amended pending claims 1, 3-4, 6-8 and cancelled claims 2, 5, 9, 11 and 13 and added new claims 14 and 15. In response to the applicant's amendments, the prior rejection is withdrawn and new rejections are applied as set forth below. As the new rejections are in response to the applicant's amendments, this action is made final.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7-8 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2002-244321.

JP '321 teaches a photoconductor comprising a charge generating layer comprising a crystalline phthalocyanine composite. Said phthalocyanine composite is comprised of a co-crystal of a titanyl phthalocyanine and a metal free phthalocyanine having the structures represented in Chemical Formulas 5 and 6, respectively ([0041-42]). Said Chemical Formulas 5 and 6 correspond to the applicant's Formulas (1) and (2) of pending claim 1, respectively. Chemical Formula 5 of JP '321 corresponds to the applicant's Formula (1) wherein t, u, v, and w are 0, as defined by JP '321 in paragraph

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[0044] and Chemical Formula 6 of JP '321 corresponds to the applicant's Formula (2) wherein at least one of t, u, v and 2 are an integer of from 1-4 and represent a halogen atom, as defined by JP '321 in paragraph [0044]. Furthermore, the crystalline phthalocyanine composition of Chemical Formulas 5 and 6 is taught to have a single x-ray diffraction spectrum and therefore is a eutectic crystalline structure ([0045], Claim 1). The photoconductor taught by JP '321 may either a monolayer type or laminate type photoconductor, wherein both types of photoconductor comprise a conductive substrate with either a single photosensitive layer provided thereon or a function separated photosensitive layer wherein the phthalocyanine composition is contained within a charge generating layer ([0051-52]).

The applicant's pending claim 3 is recited as product-by-process claim. In a product by process claim, so long as the product has the same claimed composition or properties, the method by which it was made or by which the properties were tested is not material. According to the MPEP, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (MPEP 2113 [R-1], see *In re Thorpe*, 777F.2d 695, 698, 227 USPQ 964, 966).

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-244321 in view of Adachi *et al.* (US PGP 2002/0102108).

The complete discussion of JP '321 above is included herein. JP '321 teaches a photoreceptor for use in an image forming apparatus but does not teach a configuration for such an apparatus.

Adachi *et al.* teach an image forming apparatus utilizing the transfer type electrophotographic process as well as the contact charging method (p. 3 [0048]). Adachi further teaches the components of the apparatus and their intended function, wherein the apparatus comprises an image bearing member (photoreceptor, p. 10 [0174]), a charging roller or magnetic brush for charging the photoreceptor ([0175-76]), an image exposure means for forming an electrostatic image ([0177]), a developing means for developing the electrostatic latent image with a toner ([0179-80]), and a transfer means for transferring the image (p. 11 [0181]). Adachi also teaches that the magnetic brush may be the charging member and contacts the photoreceptor in the charging step (p. 8 [0148]). Alternatively, the charging roller may also serve as the contact charging member by contacting the photoreceptor in the charging step (p. 5 [0097]). The process cartridge taught by Adachi *et al.* contains a photoreceptor as well as at least one of a charging means, developing, means, and cleaning means and is attachable and detachable from the imaging apparatus (p. 11 [0183]).

As noted above, JP '321 teaches a photoreceptor for use in an image forming apparatus but does not teach such an apparatus. Adachi teaches an image forming apparatus and process cartridge configured to contain a photoreceptor. Therefore, it

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would have been obvious to any person of ordinary skill in the art at the time of the invention to have used the photoreceptor taught by JP '321 in an image forming apparatus comprising a process cartridge like the one taught by Adachi *et al.* Since the function of said photoreceptor is to accept a latent image which is subsequently developed by a toner in a printing operation, one of ordinary skill in the art would have sought out a disclosure of a suitable image forming apparatus in which to employ the photoconductor taught by JP '321. Therefore, one of ordinary skill in the art would have looked to the disclosure of Adachi, which describes a suitable image forming apparatus and process cartridge, in an attempt to utilize the invention of JP '321.

### ***Allowable Subject Matter***

Claims 4, 6 and 15 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose a phthalocyanine composite having a eutectic crystalline structure as recited in pending claim 4, wherein M3 and M4 are selected from the 13<sup>th</sup> group of the periodic table and at least one of Y1 and Y2 are a halogen atom. Such crystalline composites are known in the prior art wherein the central metal is titanium, but not wherein said central metal is selected from the 13<sup>th</sup> group of the periodic table. Furthermore, eutectic composites formed from aluminum phthalocyanines and copper phthalocyanines are also known, but not wherein both central metal atoms are selected from the 13<sup>th</sup> group of the periodic table.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER L. VAJDA whose telephone number is (571)272-7150. The examiner can normally be reached on 7:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/  
Primary Examiner, Art Unit 1721

/PLV/ 11/05/2010